

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 03, 2012 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 42, 46, 63-65, 68-69** are rejected under 35 U.S.C. 102(b) as being anticipated by Holmberg et al. (US 4447481).

4. Regarding claim 42, Holmberg discloses a paper sheet, i.e. an index card, (title) for printing, i.e. writeable surface (column 1, lines 23-25) and a mounting surface on a opposite side thereof (column 1, lines 27-40). The paper sheet of Holmberg has a recess formed (12, figure 3, column 1, lines 63-65) on a side of the substrate (10, figure 3, column 1, line 63) and repositionable pressure sensitive adhesive disposed only

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within the recess (14a, figure 7, column 2, lines 33-35 and line 55), the recess having a depth, relative to an unrecessed portion of the second side of the first substrate (see figures 3 and 7) and the first side of the substrate having no surface discontinuities.

Given that the combined thickness of adhesive and protective strip, i.e. securing mechanism, is no greater than the depth of recess (column 1, line 67 to column 2, line 1), it is clear that there is sufficient to space the adhesive from the mounting substrate in the absence of the application of the threshold level of pressure wherein in the absence of a threshold level of pressure applied on the first side of the first substrate to the securing mechanism, the pressure sensitive adhesive is spaced from the mounting substrate, and wherein the sheet is deformable such that a threshold level of pressure applied to the first side of the first substrate on the securing mechanism brings the pressure sensitive adhesive into sheet securing engagement with the mounting substrate. Further, Holmberg discloses that the sheets are stacked, i.e. sheets are arranged top to bottom such that second side of a first sheet is in contact with first side of a second sheet, (column 1, lines 25-26) and that the combined thickness of adhesive and protective strip is no greater than the depth of recess. Given that sheet of Holmberg discloses the same structure as presently claimed, it is clear that when the strip is removed, the repositionable adhesive on said second side of said first index card is exposed to said first side of said second card and the sheets do not stick to one another.

5. Regarding claim 46, Holmberg discloses the same paper sheet, i.e. index card, as disclosed in present claim, it is clear that upon removal of the sheet from the

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mounting substrate, the securing mechanism substantially returns to its original undeformed shape.

6. Regarding claim 63, Holmberg discloses paper sheet wherein the first substrate has upper edge and wherein the recess has an upper border which extends along and is spaced from the upper edge of the first substrate (see figure 5).

7. Regarding claim 64, Holmberg discloses paper sheet wherein the first substrate has first and second side edges, and wherein the recess extends across the first substrate from first side edge to the second side edge thereof (see figure 6).

8. Regarding claim 65, Holmberg discloses paper sheet wherein the exposed pressure sensitive adhesive has an edge on the second side of the first substrate (figure 3), and wherein the security mechanism comprises a spacer layer (10, figure 3) of material on the second side of the first substrate adjacent the edge of the exposed pressure sensitive adhesive (the area of figure 3 where there is no recess and its thicker than the recess), the spacer layer having a shape relative to the adhesive and having a height of the adhesive, said shape and height of the spacer layer being sufficient to space the adhesive from the mounting substrate in the absence of the application of the threshold level of pressure (see figure 7).

9. Regarding claims 68 and 69, given that the paper sheets are stacked (column 1, lines 25-26) and the combined thickness of the adhesive and protective strip is no greater than the depth of the recess (column 1, line 67 to column 2, line 1), it is clear that when a stack of comprising two or more index cards are arranged top to bottom,

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cards do not stick to one another and cards can be shuffled without adhering to other cards.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claim 70** is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg et al. (US 4447481).

12. Regarding claim 70, Holmberg does not disclose a plurality of ruled lines on the surface of paper. However, the court found that matters relating to ornamentation only, such as ruled lines, which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See Ex parte Hilton, 148 USPQ 356 (Bd. App. 1965). Therefore, it would have been obvious to one of ordinary skill in the art to modify the sheet of Holmberg with any ornamentation, including lines, depending on the desired design and end use.

13. **Claims 56-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg et al. (US 4447481) in view of Sommers (U.S. 5924227).

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14. Holmberg discloses pressure sensitive adhesive sheet as described above.

Regarding claims 56-58, Holmberg fails to meet the limitation of present claims.

15. Sommers discloses an index card wherein a score line on the substrate which is placed from and parallel to the upper edge of the substrate and a cut formed through the substrate, the cut extending from a first end on the score line toward the upper edge to a first turn, extending from the first turn along and spaced from the upper to a second turn, and then extending from the second turn away from the upper edge to a second end of the cut on the score line (figures 2 and 3).

16. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the folding mechanism of Sommers with the sheet structure of Holmberg so that it is easy to view and handle.

17. Regarding claims 59-60, Holmberg discloses pressure sensitive adhesive sheet wherein it comprises pressure sensitive adhesive (column 1, lines 35-36). Holmberg alone fails to meet all the limitation as present claims.

18. Sommers discloses an index card wherein the spacing portion of the substrate being folded over so that it lean towards the second side of the substrate, thereby forming a raised layer on the second side of the substrate which defines the standoff element and which has a higher thickness than the substrate (figures 2 and 3).

19. It would have been obvious to one of ordinary skill in the art at the time of the invention to put pressure sensitive adhesive of Holmberg on the folded portion to have better adhesion than just folding.

Response to Arguments

20. Applicant's arguments filed January 03, 2012 have been fully considered but they are not persuasive.

21. Applicant argues that Holmberg discloses adhesive strip is covered by a release liner. It is agreed, however, it is noted that the structure of the recess and adhesive layer is the same as presently claimed (Holmberg, figure 7) and therefore in absence of threshold level of pressure, the index card of Holmberg would not stick to one another.

22. Further, it is noted that Holmberg et al. discloses adhesive that can be removably attached, i.e. repositionable (column 2, lines 33-35). Therefore it is clear that when the strip of Holmberg is removed, the adhesive would be exposed to first side of second index card and first index card and second index card necessarily would not stick to one another.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMIR SHAH whose telephone number is (571)270-1143. The examiner can normally be reached on 8am to 5pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMIR SHAH/
Examiner, Art Unit 1787

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Supervisory Patent Examiner, Art Unit 1787